

REMARKS

The Examiner rejected the pending claims in view of Doss in combination with Schachar and Wuchinich. The Examiner states that although Doss does discuss keeping the electrode out of contact with the cornea, the Doss reference does not caution against contact in a manner contemplated by Schachar. The Examiner then states that because both Doss and Schachar provide a means to prevent overheating of epithelium, that these approaches are interchangeable. The Applicant respectfully traverses this contention.

To create a *prima facie* case of obviousness, there must be some suggestion or motivation in either the references or knowledge generally available to one skilled in the art to modify or combine the references. MPEP §2143. As discussed in the Background of the above entitled application and cited by the Doss reference, there existed a procedure, like Schachar's, wherein a tip is heated and inserted into a cornea. As noted by the Applicant in the Background of the application (see page 6 regarding the discussion of Feldman and acknowledged by Doss, such a procedure did not provide an adequate thermal profile and would result in a regression of the corneal correction. Doss addressed this deficiency by providing an RF electrode that delivered electro-magnetic energy into the stroma of the cornea. It was Doss belief that the electrode would have to be spaced from the cornea to allow a cooling fluid to flow over the epithelium layer. The Applicant recognized two deficiencies in this approach. One, spacing the electrode away from the cornea would not allow for the proper delivery of energy into the stroma. Second, inserting the electrode into the stroma allows for the use of lower power and eliminates the need for a cooling solution.

The Applicant submits that the Examiner's combination of Doss and Schachar is merely hindsight reconstruction of the claimed invention. The test for obviousness includes the requirement that the references suggest to one skilled in the art the claimed invention. The Applicant submits that Doss was one skilled in the art. In his discussion in the Background of his patent, Doss acknowledged the existence of a thermal probe technique such as Schachar. Doss was also knowledgeable about the utilization of an RF electrode to change the shape of a cornea. Yet Doss failed to conceive an approach wherein an RF electrode is inserted into the stroma. Nowhere in Doss is it even suggested that the RF electrode be inserted into the stroma. The fact, as noted by the Applicant in prior Responses, Doss explicitly teaches away from

contact between the electrode and the cornea. Likewise, Schachar does not suggest modifying the probe to be an RF electrode.

The Examiner believes that the Doss and Schachar approaches are interchangeable because they both address the issue of preventing excessive heating of the epithelium. The Applicant submits that the approaches are not interchangeable because the Schachar approach would not prevent overheating of the epithelium in an RF based system. Schachar discloses insulating the body 60 of a needle so that only the tip portion 62 is heated. Thermally insulating the RF electrode of Doss would not prevent overheating of the epithelium. The thermal insulator of Schachar would neither cool the epithelium or prevent the application of RF energy into the epithelium layer. Modifying Doss to include the thermally insulated electrode body of Schachar would not accomplish one of the stated goals of Doss – to prevent overheating of the epithelium. For all of the above reasons, the Applicant submits that the combination of Doss, Schachar and Wuchinich does not render unpatentable the pending claims of the above entitled application.

In view of the above it is submitted that the claims are in condition for allowance. Reconsideration of the rejections is requested. Allowance of claims 11, 13-14, 16, 18, 20-21 and 23 at an early date is solicited.

Respectfully submitted,
IRELL & MANELLA LLP

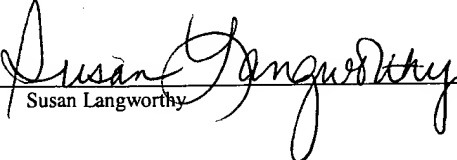
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Ben J. Yorks, Reg. No. 33,609

840 Newport Center Drive, Suite 400
Newport Beach, CA 92660
949-760-0991

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on December 15, 2005.

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Susan Langworthy Date